



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No.

KAREN J. MESSICK, ESQ.
c/o KOS PHARMACEUTICALS, INC.
1001 BRICKELL BAY DRIVE
25TH FLOOR
MIAMI, FL 33131

COPY MAILED

APR 11 2003

OFFICE OF PETITIONS

In re Application of
Eugenio A. Cefali
Application No. 08/962,027
Filed: October 31, 1997
Attorney Docket No. 20720-95585

ON PETITION

This is a decision on the petitions filed January 16, 2003, to (1) revive the above-identified application under 37 CFR 1.137(b) and (2) withdraw the above-identified application from issue after payment of the issue fee under 37 CFR 1.313(c)(2). This is also notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The renewed petition under 1.137(b) is **GRANTED**.

The application became abandoned for failure to timely pay the issue fee in response to a Notice of Allowance mailed March 2, 2001. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. See MPEP 711.03(c)(III)(A)(1).

On September 28, 2001, a petition to revive was filed along with the \$620 payment of the issue fee as a small entity. However, the petition was dismissed in a decision mailed October 16, 2001, since there was no indication that the formal drawings required by the Notice of Allowability mailed March 2, 2001 had been filed.

On January 16, 2003 petitioner submitted, inter alia, (1) a petition under 1.181(a) or, in the alternative, a petition under 37 CFR 1.137(b), including formal drawings and the balance of issue fee as a large entity; (2) a petition under 37 CFR 1.313(c)(2), including a Request for Continued Examination and a Preliminary Amendment; and (3) a Request to Correct Inventorship under 37 CFR 1.48(a), including a request to perfect claim to priority pursuant to 35 U.S.C. 120.

It is noted that petitioner states that a renewed petition, the formal drawings and an appropriate extension of time were filed using a Certificate of Mailing under 37 CFR 1.8 dated April 16, 2002, in response to the Decision Dismissing Petition mailed October 16, 2001. The evidence provided January 16, 2003 complies with the requirements of 37 CFR 1.8(b). Therefore it is conceded that that the papers containing a Certificate of Mailing dated April 16, 2002, would have been considered timely if received in the U.S. Patent and Trademark Office. Under the circumstances, the alternative petition filed January 16, 2003 has been treated as a renewed petition under 37 CFR 1.137(b). Except for the fee for the 4-month petition for extension of time submitted with the original filing on April 16, 2002, no further fee is required for treatment of this petition.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. While the statement in this petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

Since petitioner has now complied with 37 CFR 1.137(b), the application may be returned to a pending status. However, in view of petitioner's request to withdraw the application from issue, the application is hereby withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2),

The petition under 37 CFR 1.313(c)(2) is **GRANTED**.

Petitioner is advised that the issue fee paid on September 28 2001, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

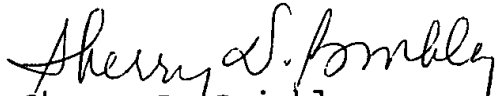
¹The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

Your fee deficiency submission under 37 CFR 1.28 is hereby
ACCEPTED.

Small entity status no longer applies.

Telephone inquiries regarding this decision should be directed to
the undersigned at (703) 305-9220.

The application is being forwarded to Technology Center 1615 for
(1) processing the request for continued examination under 37 CFR
1.114 and (2) consideration of the request to Correct
Inventorship under 37 CFR 1.48(a), including the request to
perfect claim to priority pursuant to 35 U.S.C. 120.



Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy